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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,678	03/10/2000	Kenneth L. Levy	Levy-5R	5873

23735 7590 06/23/2003

DIGIMARC CORPORATION
19801 SW 72ND AVENUE
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TUALATIN, OR 97062

EXAMINER
COBY, FRANTZ

ART UNIT	PAPER NUMBER
2171	

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/522,678	Levy
Examiner	**Art Unit**
Frantz Coby	2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Feb 26, 2003*.

2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-4, 16, and 21-43* is/are pending in the application.

4a) Of the above, claim(s) *NONE* is/are withdrawn from consideration.

5) ☒ Claim(s) *NONE* is/are allowed.

6) ☒ Claim(s) *1-4, 16, and 21-43* is/are rejected.

7) ☒ Claim(s) *NONE* is/are objected to.

8) ☒ Claims *NONE* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 10
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

This is in response to application filed on march 10 2000 in which claims 1-20 are presented for examination.

Information Disclosure Statement

1. The information disclosure statement filed on March 03, 2000 is in compliance with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has not been considered as to the merits.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 16-20 are rejected under 35 U.S.C. 112, first paragraph, because claim 16 recites a single means. A single means claim, i.e. where a means recitation does not appear in combination with another recited element of means, is subject to an undue breath rejection under 35 U.S.C. 112 first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7, 9-14, 16, 18 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the digital data" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the digital data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 1 recites the limitation "the original signal" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 2 recites the limitation "the content degradation " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the content degradation " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the degradation process" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the original signal " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the degradation process" in lines 3-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation "the original signal " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the content" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the content degraded " in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the digital data" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the original digital data" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the degraded data" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the content degradation " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the difficulty" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites the limitation "the content degradation " in line 4. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the recovery process" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the point after the threshold crossing by the inverse of the scaling value " in lines 2-4. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the recovery process " in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 16 recites the limitation "the efficient" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the memory " in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the degraded content" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 10 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Suzuki U.S. Patent no. 5,630,044.

As per claims 1 and 10, Suzuki discloses a process that includes searching digital data for detecting criteria (See Suzuki col. 2, lines 2-9). In particular, Suzuki discloses "adjusting neighboring points whereby said digital data is degraded in quality but an original signal of said digital data is recoverable (See Suzuki Col. 1, line 40 to col. 3, line 60).

As per claim 16, all the limitations of this claim have been noted in the rejection of claim 1. It is therefore rejected as set forth above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 2-3, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki U.S. Patent no. 5,630,044 in view of Shyu U.S. Patent no. 6,021,391.

As per claims 2-3 and 11-12, most of the limitations of these claims have been noted in the rejection of claims 1 and 10. Applicant's attention is directed to the rejection of claims 1 and 10 above.

Although Suzuki discloses a detection means, it is noted that Suzuki did not specifically detail the claimed feature "detection criteria involves a pseudo random sequence" or "adjustment of neighboring points involves a pseudo random sequence" as recited in the instant claims 2 and 3; 11 and 12. On the other hand, Shyu discloses a method and system for dynamic data encryption including a scrambling field type which allows the scrambling algorithm to be selected randomly (See Shyu Col. 3, lines 12-26).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the recovery system of Suzuki wherein the detection means provided thereof (See Suzuki Figure 2, component 20) would have incorporated the random scrambling teachings of Shyu. The motivation being to have enhanced the versatility of Suzuki by allowing it to provide a more efficient fault recovery system that can decrease the frequency of degradation processing to prevent the reduction of the system performance caused by degradation as much as possible (See Suzuki Col. 6, lines 27-31).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 4-9, 13-14, 15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki U.S. Patent no. 5,630,044 in view of Paneth et al. U.S. Patent no. 5,778,055.

As per claims 4-7, and 13-14, most of the limitations of these claims have been noted in the rejection of claims 1 and 10. Applicant's attention is directed to the rejection of claims 1 and 10 above.

It is noted however, Suzuki did not specifically detail the claimed feature "detection criteria includes a threshold crossing"; "the value of the threshold is a pseudo random sequence"; "scaling the point after the threshold crossing"; "the scaling value is a pseudo-random sequence" as recited in the instant claims 4-7 and 13-14. On the other hand, Paneth et al. disclose the aforementioned limitations as a detector that extracts digital information based on peaks in the received signal or by adding the signals with preset threshold values (See Paneth et al. Abstract; Col. 2, lines 44-56).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the recovery system of Suzuki wherein the detection means provided thereof (See Suzuki Figure 2, component 20) would have incorporated the threshold teachings of Paneth et al. The motivation being to have enhanced the versatility of Suzuki by allowing it to provide a more efficient fault recovery system that can decrease the frequency of degradation processing to prevent the reduction of the system performance caused by degradation as much as possible (See Suzuki Col. 6, lines 27-31).

As per claims 8-9, 15 and 20 the limitations of these claims have been noted in the rejection of claims 1 ,10 and 16. Applicant's attention is directed to the rejection of claims 1, 10 and 16 above. In addition, Paneth et al. disclose the claimed features "every Mth point is degradable in quality" (See Paneth et al. Figure 4) and "content is recovered with a filter that removes most of the content degraded" as filter 26 of figure 1 (Col. 4, line 41-col. 5, line 10).

As per claims 17-19 the limitations of these claims have been noted in the rejection of claims 1 ,10 and 16. Applicant's attention is directed to the rejection of claims 1, 10 and 16 above. In addition, Paneth et al. disclose a digital processor, random access memory and a combination of custom digital and analog circuitry (See Paneth et al. Figure 3).

Conclusion

Any response to this action should be mailed to:

Commissioner of Patents and trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-9051, (for formal communications

intended for entry)

Or:

(703) 308-5357 (for informal of draft

communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2021 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 5:00 P.M.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.

Technology Center 2171

July 26, 2002

This is in response to applicant's amendment filed on February 03, 2003 and February 26, 2003 in which claims 1-14 and 16 were amended, claims 5-15 and 17-20 were canceled, and claims 21-43 were added.

Claims Status

Claims 1-4, 16 and 21-43 are pending.

14. Applicant's arguments with respect to claims 1-4 and 16 have been considered but are moot in view of the new ground(s) of rejection.

The rejections follows:

Claim Rejections - 35 USC § 112

15. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

16. Claims 40-41 are rejected under 35 U.S.C. 112, first paragraph, because claim 40 recites a single means. Namely, "removing means for removing degradation data form an audio signal .....". A single means claim, i.e. where a means recitation does not appear in combination with another recited element of means, is subject to an undue breath rejection under 35 U.S.C. 112 first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

17. Claims 40-43 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Namely "an audio player for playing back an audio signal distributed through a network"; "An audio distribution system" and an Audio distribution method.

18. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

19. Claim 21-34 and are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 21 calls for "A method of self-synchronization of degraded digital data" in the preamble. The body of the claim simply recites a step for "analyzing the degraded digital content" and a step for "adjusting each member of a group of neighboring points". However Claim 21 fails to recite the necessary steps for arriving with "A method of self-synchronization of degraded digital data". Applicant is required to present in a manner that includes the steps that will arrive with "method of self-synchronization of degraded digital data".

Claims 22-29, being dependent directly or indirectly on claim 21, are also rejected for the same reasons given in the rejection of claim 21 above.

Also, claim 30 calls for "A method of self-synchronization of intentionally degraded digital data" in the preamble. The body of the claim simply recites a step for "analyzing the intentionally degraded digital content" and a step for "adjusting the intentionally degraded digital content". However Claim 30 fails to recite the necessary steps for arriving with "A method of self-synchronization of degraded digital data". Applicant is required to present in a manner that includes the steps that will arrive with "method of self-synchronization of degraded digital data".

Claims 31-34, being dependent directly or indirectly on claim 30, are also rejected for the same reasons given in the rejection of claim 30 above.

Claim Rejections - 35 USC § 102

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Rhoads U.S. Patent no. 5,768,426.

As per claim 1, Rhoads discloses the invention including "searching the original data for detection criteria; and after locating detection criteria, adjusting neighboring point associated with the detection criteria, wherein the original is degraded in quality by said adjusting step" (See Rhoads Col. 7, lines 18-43). Also, Rhoads discloses the invention wherein "the original is recoverable form the intentionally degraded digital data" (See Rhoads Col. 13, lines 48-55).

As per claims 2-3, most of the limitations of these claims have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Rhoads discloses "a pseudo-random sequence" involves in adjustment of the at least one neighboring point (See Rhoads Col. 6, line 51).

As per claims 4, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Rhoads discloses a "threshold crossing" as an acceptable noise level set at 1dB (See Rhoads Col. 6, lines

As per claims 16, 35 and 39, most of the limitations of this claim have been noted in the rejection of claim 1. Applicant's attention is directed to the rejection of claim 1 above. In addition, Rhoads discloses the aspect of self-synchronization through the Sync Detector such as shown in Figure 8 component 250; a processor primarily incorporated in the computer of Figure

4 component 106; a storage unit (See Rhoads Col. 18, lines 18-30); "means for analyzing digital content" (See Rhoads Col. 7, lines 18-43); and "means for recovering the original state of the digital content" (See Rhoads Col. 13, lines 48-55). Last Rhoads discloses "intentional degradation" since noise is embedded into digital signal for the purpose of corrupting the original signal (See Rhoads col. 4, lines 1-23).

As per claim 21, all the limitations of this claim have been noted in the rejection of claims 16, 35 and 39. It is therefore rejected as set forth above.

As per claims 22-23, most of the limitations of these claims have been noted in the rejection of claim 21. Applicant's attention is directed to the rejection of claim 21 above. In addition, Rhoads discloses "a pseudo-random sequence" involves in adjustment of the at least one neighboring point (See Rhoads Col. 6, line 51).

As per claims 24, most of the limitations of this claim have been noted in the rejection of claim 21. Applicant's attention is directed to the rejection of claim 21 above. In addition, Rhoads discloses a "threshold crossing" as an acceptable noise level set at 1dB (See Rhoads Col. 6, lines

As per claims 26-28, most of the limitations of these claims have been noted in the rejection of claim 21. Applicant's attention is directed to the rejection of claim 21 above. In addition, Rhoads discloses has made illustration of several exemplary of audio content, video content and image content (See Rhoads Col. 1, lines 17-22).

As per claims 29, most of the limitations of this claim have been noted in the rejection of claim 21. Applicant's attention is directed to the rejection of claim 21 above. In addition, Rhoads discloses "intentional degradation" since noise is embedded into digital signal for the purpose of corrupting the original signal (See Rhoads col. 4, lines 1-23).

As per 30, all the limitations of this claim have been noted in the rejection of claims 16, 35 and 39. It is therefore rejected as set forth above.

As per claims 31-32, most of the limitations of these claims have been noted in the rejection of claim 30. Applicant's attention is directed to the rejection of claim 30 above. In addition, Rhoads discloses the adjusting step including neighboring points that help to restore the intentionally degraded digital content to the original state (See Rhoads Col. 13, lines 48-55).

As per claims 33-34, most of the limitations of these claims have been noted in the rejection of claim 30. Applicant's attention is directed to the rejection of claim 30 above. In

addition, Rhoads discloses has made illustration of several exemplary of audio content, video content and image content (See Rhoads Col. 1, lines 17-22).

As per claims 36-39, most of the limitations of these claims have been noted in the rejection of claims 16, 35 and 39. In addition Rhoads disclose a process used to degrade the digital content; means that helps restore the degraded digital content (See Rhoads Col. 13, lines 48-55), and adjusting step including neighboring points that help to restore the intentionally degraded digital content to the original state (See Rhoads Col. 13, lines 48-55).

As per claims 40-43, all the limitations of these claims have been noted in the rejection of claims 1-39 above. Namely, removing degradation dat form an original signal, embedded degradation data in an original data. They are therefore rejected as set forth above.

Conclusion

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any response to this action should be mailed to:

Commissioner of Patents and trademarks

Washington, D.C. 20231

or faxed to:

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Or:

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz Coby whose telephone number is (703) 305-4006. The examiner can normally be reached Monday through Friday from 9:30 A.M. to 5:00 P.M.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-14367. The Fax phone number for this Group is (703) 746-7238; (703) 746-7239; (703) 746-7240.

Frantz Coby

FRANTZ COBY
PRIMARY EXAMINER

Technology Center 2171

June 15, 2003